

REMARKS

In the Office Action, the Examiner withdrew a previous indication of allowability and rejected claims 1-9, 11, and 25-28. Applicants note that claims 10, 12-23, and 29-33 were canceled in previous communications. Particularly, a substantial number of these claims were canceled by Applicants in order to place the present application in condition for allowance based on the subject matter previously indicated as allowable by the Examiner. These canceled claims included three independent claims, two of which were generally directed to systems and a third claim that was generally directed to a method of communicating information wirelessly between components of a computer system.

Consequently, in view of the earlier cancellation of claims in reliance on the indication of allowable subject matter, and the subsequent withdrawal of the same indication, Applicants add new claims 34-49. Applicants believe that these new claims should be classified in the same manner as the claims that were previously canceled and respectfully request examination of these claims. Additionally, Applicants amend claims 1, 8, 11, and 25 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1-9, 11, 25-49 will be pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-5 under U.S.C. § 102(e) as anticipated by Abbott et al. (U.S. Patent No. 6,671,808). The Examiner also rejected claims 25-28 under 35 U.S.C. § 102(a) as anticipated by Bork (U.S. Patent No. 6,255,800). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.

1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the identical invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Omitted Features of Independent Claim 1

Turning now to the present claims, the Abbott et al. reference fails to disclose each element of independent claim 1. For instance, independent claim 1, as amended, recites first and second electronic devices and “a dongle having an antenna for transmitting and receiving information and a USB connector for selective mating engagement with the USB port, wherein the weight of the dongle is supported entirely by the mating engagement of the USB connector to the USB port, and *wherein the dongle is configured to facilitate communication between the first and second electronic devices*” (emphasis added). Because the Abbott et al. reference fails to disclose such an element, the cited reference fails to anticipate independent claim 1.

The Abbott et al. reference is generally directed to computer system security and, more specifically, a personal key 200 that provides integrated password and digital certificate management, software security, and personal identification capability. *See* col. 1, lines 15-19; col. 5, lines 41-45; FIGS. 2A-2C. The personal key 200 of Abbott et al. includes a processor 212 and a memory 214 disposed on a circuit board 206. Col. 5, lines 54-67. Notably, the memory 214 is used to store private data and information, such as passwords, digital certificates, cookies, and the like. *See* col. 3, lines 26-43. The personal key 200 may interface with a computer 102 to provide personal data stored in

memory 214, such as passwords, to the computer 102. *See, e.g.*, col. 4, line 51 – col. 5, line 14.

In the Office Action, the Examiner equated the personal key 200 of Abbott et al. with the dongle recited by independent claim 1. Particularly, the Examiner relied on passages of the Abbott et al. reference that suggest the inclusion of a transceiver to facilitate communication between the personal key and other devices. *See* Office Action mailed February 23, 2006, page 3. In one passage, the Abbott et al. reference notes that an infrared transceiver could be included, which “allows the personal key to exchange information with a wide variety of computers and peripherals without physical coupling.” Abbott et al., col. 3, lines 56-62. In another passage, Abbott et al. note that the inclusion of an IR receiver “is particularly useful, because it provides the personal key 200 another means for communicating with external peripherals and devices, even when the personal key 200 is already coupled [to a host computer].” Col. 8, lines 28-32. Abbott et al. further note that “a paging transceiver can be incorporated into the personal key to allow the user to be summoned or contacted remotely.” Col. 6, lines 62-66.

However, in each of the above instances, Abbott et al. teach the inclusion of a transceiver to communicate data between a peripheral device and *the personal key itself*. This, of course, is in accordance with the function of the personal key as a centralized repository of personal data, including passwords, cookies, and the like. At no point does the Abbott et al. reference teach, disclose, mention, or even hint at using the personal key as an *intermediary* in communicating between two separate electronic components or devices. Consequently, the Abbott et al. personal key cannot be reasonably considered “a dongle having an antenna for transmitting and receiving information and a USB connector for selective mating engagement with the USB port, ... *wherein the dongle is configured to facilitate communication between the first and second electronic devices*” (emphasis added), as recited by amended independent claim 1. Because the cited

reference fails to teach every element, the Abbott et al. reference cannot anticipate claim 1 or claims 2-5, which depend therefrom.

Omitted Features of Independent Claim 25

Further, the Bork reference fails to disclose each element of independent claim 25. For instance, independent claim 25, as amended, recites a wireless communication system including “at least one communication dongle having ... a USB connector for selective mating engagement with the first USB port and the second USB port, *wherein the weight of the at least one communication dongle is supported entirely by the mating engagement of the USB connector to the first or second USB port*” (emphasis added). Because the Bork reference fails to disclose each and every element of the instant claim, the cited reference fails to anticipate independent claim 25.

The Bork reference is generally directed to a charging cradle 46 for a portable electronic device, such as a portable telephone 14. *See, e.g.*, col. 5, lines 35-47; FIG. 10. The charging cradle 46 may be connected to a computer 10 via a cable 12. *See, e.g.*, FIG. 10. The Bork charging cradle 46 includes an antenna 42 and a transceiver 44. *See, e.g., id.* In the Office Action, the Examiner equated the transceiver 44 and the charging cradle 46 of Bork with the wireless communication system recited by independent claim 25. *See* Office Action mailed February 23, 2006, page 5. The Examiner also equated the Bork charging cradle 46 to the recited “at least one communication dongle” of the instant claim.

As a preliminary matter, even when considered in a vacuum independent of the intrinsic record, Applicants respectfully submit that one of ordinary skill in the art would not consider a charging cradle, such as that disclosed by Bork, to be a “dongle.” Moreover, as the Examiner certainly appreciates, claim recitations, in fact, cannot be considered in such a vacuum, but must be interpreted in view of the specification. Applicants certainly appreciate the difficulty faced by the Examiner in interpreting the

claims in view of the specification without improperly importing limitations from the specification into the claims. However, Applicants respectfully note that the Federal Circuit, sitting *en banc*, recently provided a summary and additional guidance regarding the proper interpretation of claims in view of the specification. See *Phillips v. AWH Corp.*, No. 03-1269, -1286 (Fed. Cir. 2005). In *Phillips*, the Federal Circuit again emphasized the primacy of the specification and intrinsic evidence in claim interpretation. Particularly, the *Phillips* court noted that the specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; *it is the single best guide to the meaning of a disputed term.*” *Phillips*, slip op. at 13 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)) (emphasis added). Moreover, the court also noted that:

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language *and most naturally aligns with the patent's description of the invention* will be, in the end, the correct construction.

Phillips, slip op. at 15 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)) (emphasis added). Applicants respectfully submit that, particularly in view of the specification, the charging cradle disclosed by Bork cannot be reasonably equated with the “at least one communication dongle” recited by the instant claim.

Additionally, even assuming, for the sake of argument, that the charging cradle disclosed in the Bork reference could be reasonably considered to be a “dongle” as the term is used in the present application, the Bork charging cradle is clearly designed to be supported by an external member, such as a desk or a table, and is not configured to be supported entirely by engagement of a USB connector to a USB port of a computer. As such, the charging cradle taught by Bork cannot be logically considered to be “the at least one communication dongle” recited by amended claim 25, in which “the weight of the at least one communication dongle

is *supported entirely* by the mating engagement of the USB connector to the first or second USB port” (emphasis added). Because the cited reference fails to teach or disclose each and every element, the Bork reference fails to anticipate independent claim 25 and its dependent claims 26-28.

For these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and allowance of claims 1-5 and 25-28.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over the Abbott et al. reference in view of Official Notice taken by the Examiner. Additionally, the Examiner rejected claims 7-9 and 11 under 35 U.S.C. § 103(a) as unpatentable over the Abbott et al. reference in view of the Bork reference and the Official Notice taken by the Examiner with respect to claim 6. Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the

obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Deficiencies of the Rejections

First, Applicants respectfully traverse the Examiner's use of Official Notice and characterization of the wireless USB protocol. Particularly, in the Office Action, the Examiner stated "[t]he wireless USB protocol is but one well-known example [of an old and well-known wireless communication standard]." While Applicants certainly do not claim to have invented wireless communication itself, Applicants respectfully note that the standard actually known as "the wireless USB protocol" was first released to the public on May 24, 2005, nearly five years *after* the filing of the present application. See "Wireless USB Specification Now Available to Public," which is publicly available at http://www.usb.org/press/pressroom/2005_05_24_USBIF2.pdf (as of May 2, 2006). Consequently, contrary to the Examiner's characterization, the wireless USB protocol cannot be used to support the Examiner's use of Official Notice.

Second, regardless of the propriety of the Examiner's use of Official Notice, Applicants note that each of claims 6-9 and 11 ultimately depends from independent claim 1. As discussed above, the Abbott et al. reference fails to disclose each element of independent claim 1. Further, the Bork reference does nothing to obviate the deficiencies of the Abbott et al. reference. As a result, dependent claims 6-9 and 11 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 103 and allowance of claims 6-9 and 11.

New Claims

As noted above, new claims 34-49 have been added by this Response. These new claims add no new matter and are fully supported throughout the specification.

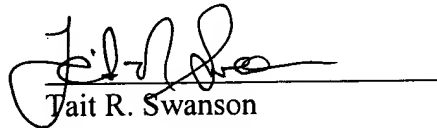
Furthermore, in view of the earlier cancellation of claims 10, 12-24, and 29-33 which included three independent claims, no fees are believed due for the addition of claims 34-49 in this Response. For reasons including those provided above with respect to independent claims 1 and 25, claims 34-49 are patentable over the cited references and are believed to be in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 34-49.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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